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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Yuanjie Chen

Title: SELECTABLE TRAINING SIGNALS BASED ON STORED PREVIOUS CONNECTION INFORMATION FOR DMT-BASED SYSTEM

Application No.: 09/863,522 Filed: May 23, 2001

Examiner: Jefferey F. Howard Group Art Unit: 2644

Atty. Docket No.: 1005-0024

May 7, 2003

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05/09/2003 ASONDAF1 00000155 09863522
01 FC:1453

CONDITIONAL PETITION TO REVIVE (37 C.F.R. § 1.137(f))

This is a *conditional* petition to revive the above-identified application (hereinafter, the "Application"), which may be regarded as abandoned for failure to notify the Office of a filing in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, of an application directed to the invention disclosed in the Application (hereinafter, a "Foreign Filing").

Although no indication exists that the Application has been abandoned, or regarded as abandoned, a recent pre-OG notice issued by the Office on 11 April 2003 reports an interpretation of 35 U.S.C. § 122 that tends to *suggest* that, even if a non-publication request is properly rescinded under § 122(b)(2)(B)(ii) before any Foreign Filing, the notice requirement under 35 U.S.C. § 122(b)(2)(B)(iii) must also be satisfied. Otherwise, the pre-OG notice reports, failure of the applicant to provide the required notice shall result in the application being regarded as abandoned.

The undersigned respectfully requests clarification or contrary official interpretation from the Office, as outlined below, that a rescission made before a Foreign Filing is sufficient under the Statute and Regulations to place the applicant in the same position as if no non-publication request had been made and, as a result, under such circumstances, the Notice requirements of 35 U.S.C. § 122(b)(2)(B)(iii) are simply inapplicable.

In the first alternative, Applicant requests the Director to determine that, though not made within 45 days after a Foreign Filing, it has been shown to the satisfaction of the Director that the entire delay in submitting the notice was unintentional and that no abandonment has or will occur as a result.

Ref. Ref: 07/07/2003 AKELLEY 0008164900
Dkt:590631 Name/Number:09863522
FC: 9204 \$1300.00 CR

conditional petition to revive (37 cfr 1.137(f))

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OFFICE OF PETITIONS

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In the second alternative, and if necessary, Applicant petitions under 37 C.F.R. § 1.137(f) to revive the application.

REQUEST FOR DETERMINATION THAT RESCISON MADE BEFORE FILING IN A FOREIGN COUNTRY IS SUFFICIENT UNDER THE STATUTE AND REGULATIONS

Applicant made a non-publication request under 35 U.S.C. § 122(b)(2)(B)(i) and 37 C.F.R. § 1.213(a) in the above-identified application. Applicant rescinded that request,¹ and then subsequently filed in a foreign country that requires publication of applications 18 months after filing, an application directed to the invention disclosed in the above-identified Application. The undersigned believes that, if the statutory language ("rescind") is properly construed, a court of competent jurisdiction will find that proper rescission made before a Foreign Filing obviates the need for an additional notice under 35 U.S.C. § 122(b)(2)(B)(iii).

As summarized above, the pre-OG notice of 11 April 2003 reports an interpretation of 35 U.S.C. § 122 that tends to suggest that, even if, as here, a non-publication request is rescinded before any Foreign Filing, the notice requirement under 35 U.S.C. § 122(b)(2)(B)(iii) must also be satisfied. Otherwise, the pre-OG notice reports, failure to provide the required notice shall result in abandonment of the application.

The pre-OG notice goes on to rationalize that despite the Office's interpretation of a separate notice requirement, some rescissions, namely those based on language of the USPTO's current form (PTO/SB/36, revision April 2001 or later) are sufficient to provide the required notice. The implication is that rescissions based on prior language are insufficient. For clarity, the revised rescission includes the following note:

Note: Filing this rescission of a previous nonpublication request is considered the notice of a subsequent foreign or International filling required by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) if this rescission is filed no later than forty-five days (45) days after the date of filing of such foreign or international application. See 37 CFR 1.137(f) if a notice of subsequent foreign or International filling required by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is not filed within forty-five days (45) days after the date of filing of the foreign or international application.

The undersigned respectfully highlights the somewhat tortured distinction suggested by the Office, namely (1) the sufficiency of a filing that recites, virtually as a footnote, the Office's determination that rescission of a non-publication request is considered the notice required by 35 USC § 122(b)(2)(B)(iii) and 37 CFR § 1.213(c) and (2) the insufficiency of a filing that does not recite the Office's determination.

Whatever the vitality of the Office's distinction, the undersigned respectfully suggests that the statutory language "rescind" should be given its ordinary and customary meaning, namely "removal as if never presented."² If so construed, the Office will necessarily find that rescission made before a Foreign Filing obviates any notice requirement.

¹ A copy of the rescission is attached.

² See Black's Law Dictionary ("Rescind. To declare a contract void in its inception and to put an end to it as though it never were. ... Not merely to terminate it and release parties from further obligations to each other but to abrogate it from the beginning and restore parties to relative positions which they would have occupied had no contract ever been made) (1979).

In particular, rescission of a non-publication request means removal of the non-publication request as if never filed. Therefore, if an applicant rescinds *prior* to any Foreign Filing, no non-publication request is extant when the applicant subsequently files in a foreign country. Instead, it is as if no non-publication request was filed and no notice under 35 U.S.C. § 122(b)(2)(B)(iii) or 37 C.F.R. § 1.213(c) is required.

Accordingly, Applicant respectfully requests that the Office determine that where, as here, a rescission is made before filing in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the notice requirement(s) of 35 U.S.C. § 122(b)(2)(B)(iii) or 37 C.F.R. § 1.213(c) are simply inapplicable, and that no abandonment has or will occur in the Application.

NOTICE OF FILING IN A FOREIGN COUNTRY OR UNDER MULTILATERAL
INTERNATIONAL AGREEMENT (35 U.S.C. § 122(b)(2)(B)(III) AND 37 C.F.R. § 1.213(c)),
AND REQUEST FOR DETERMINATION THAT,
THOUGH NOT MADE WITHIN 45 DAYS AFTER SUCH FOREIGN FILING, DELAY IN
SUBMISSION OF NOTICE WAS UNINTENTIONAL AND THAT AS A RESULT,
NO ABANDONMENT HAS OR WILL OCCUR

In the first alternative, and if required, the undersigned provides notice under 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c) and states that the entire delay in submission of such notice was unintentional. Relevant facts are as follows:

1. Applicant made a non-publication request under 35 U.S.C. § 122(b)(2)(B)(i) and 37 C.F.R. § 1.213(a) upon filing the Application on May 23, 2001.
2. Applicant rescinded the non-publication request on November 9, 2001.
3. Applicant subsequently filed in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, an application directed to the invention disclosed in the Application. Specifically, Applicant hereby notifies the Director and Office in accordance with 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c) of the following application:
 - (a) a counterpart European patent application, application number 02250274.4, filed on January 14, 2002.
4. Though not made within forty-five (45) days of such filing, the entire period of delay in making such notification was unintentional. Indeed, the Office's somewhat novel interpretation that certain rescissions were effective (even though absent specific notification of such foreign filings), while other rescissions were ineffective, was not even made (in the form of a pre-OG notice), until less than 4 weeks ago. Preparation and filing of this paper was initiated promptly thereafter.

Accordingly, the undersigned respectfully requests a determination, in accordance with 35 U.S.C. § 122(b)(2)(B)(iii), that to the satisfaction of the Director, the delay in submitting the notice was unintentional, and that the Application has not nor will not be regarded as abandoned.

CONDITIONAL PETITION UNDER 37 C.F.R. § 1.137(f)

Finally, in the second alternative, Applicant respectfully petitions under 37 C.F.R. § 1.137(f) to revive the Application.

1. Applicant hereby notifies the Director and Office in accordance with 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c) of the Foreign Filing listed below:
 - (a) a counterpart European patent application, application number 02250274.4, filed on January 14, 2002.
2. The entire delay in submission of this notice was unintentional.
3. The petition fee set forth in 37 C.F.R. § 1.17(m) (the "Petition Fee") (\$1300) is enclosed herewith.
4. As the Application is a utility application filed on or after June 8, 1995, no terminal disclaimer is required.

Payment of the Petition Fee is as follows:

- A check is enclosed for the Petition Fee shown above.
- Please charge the Petition Fee shown above to Deposit Account 50-0631.
- Please charge the Petition Fee shown above to credit card (Form PTO-2038 enclosed).
- The Director is hereby authorized to charge any additional fees under 37 C.F.R. § 1.16 or 1.17 that may be required during the pendency of this application, and to similarly credit any overpayment, to Deposit Account 50-0631.

<u>CERTIFICATE OF MAILING OR TRANSMISSION</u>	
I hereby certify that, on the date shown below, this correspondence is being	
<input type="checkbox"/> deposited with the US Postal Service with sufficient postage as first class mail, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231.	
<input type="checkbox"/> facsimile transmitted to the US Patent and Trademark Office.	
_____ David W. O'Brien	_____ Date
EXPRESS MAIL EV335379304US	

Respectfully submitted,


David W.O'Brien, Reg. No. 40,107
 Attorney for Applicant(s)
 (512) 347-9030
 (512) 347-9031 (fax)